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10/534,339	05/10/2005	David Phillip Devonald	056258-5105	4731

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MORGAN LEWIS & BOCKIUS LLP  
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WASHINGTON, DC 20004

EXAMINER
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MARTIN, LAURA E

ART UNIT	PAPER NUMBER
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2853

MAIL DATE	DELIVERY MODE
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08/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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# Office Action Summary

Application No.

10/534,339

Applicant(s)

DEVONALD, DAVID PHILLIP

Examiner

Laura E. Martin

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-20, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 9-11, 15-20, 22 and 23 is/are rejected.
- 7) ☒ Claim(s) 5, 7, 8, 12 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/10/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

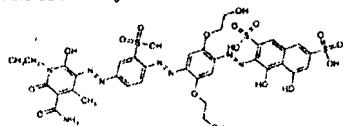
Claims 1 and 6 are rejected on the ground of nonstatutory double patenting over claim 1 of U. S. Patent No. US 7153351 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

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Art Unit: 2853

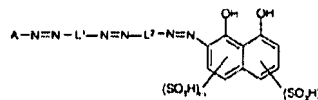
1. (original): An ink comprising a liquid medium and a tris-azo compound of Formula (1) or salt thereof:



Formula (1)

wherein the liquid medium comprises water and an organic solvent.

1. (original): A process for printing an image on a substrate comprising applying thereto a composition comprising a liquid medium and a tris-azo compound of Formula (1) or salt thereof:



Formula (1)

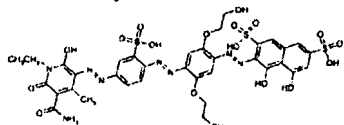
wherein:

A is an optionally substituted alkenyl, homocyclic or heterocyclic group;  
L¹ and L² are each independently optionally substituted aryl or heteroaryl; and  
m and n are each independently 0 or 1 such that m+n is 1 or 2;

wherein:

- (i) the compound of Formula (1) is optionally in the form of a metal chelate; and
- (ii) at least one of L¹ and L² carries at least one substituent selected from sulfo, carboxy, C₁-₄-alkoxy and C₁-₄-alkoxy-OH.

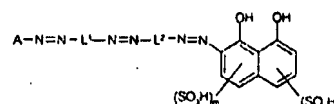
1. (original): An ink comprising a liquid medium and a tris-azo compound of Formula (1) or salt thereof:



Formula (1)

wherein the liquid medium comprises water and an organic solvent.

6. (original): A tris-azo compound of Formula (1) or salt thereof:



Formula (1)

wherein:

A is an optionally substituted alkenyl, homocyclic or heterocyclic group,  
L¹ and L² are each independently optionally substituted aryl or heteroaryl;  
m and n are each independently 0 or 1 such that m+n is 1 or 2; and  
with the provisos that:

- (i) the compound of Formula (1) is optionally in the form of a metal chelate;
- (ii) L¹ and L² are each independently optionally substituted phenylene or naphthylene;
- (iii) optional substituents present on L¹ and L² are selected from OH, SO₃H, CN, carbonamido, PO₃H₂, CO₂H, NO₂, NH₂, optionally substituted alkyl, optionally substituted alkoxy, optionally substituted aryl, optionally substituted amine and optionally substituted acylamino;
- (iv) at least one of L¹ and L² carries at least one substituent selected from sulfo, carboxy, C₁-₄-alkoxy and C₁-₄-alkoxy-OH; and
- (v) when L¹ carries a methoxy group A is not 1,3-diaminophenyl.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 9-11, 15-18 rejected under 35 U.S.C. 102(b) as being anticipated by Ciba Limited (GB 741578 A).

#### **Ciba Limited discloses the following claim limitations:**

As per claims 1 and 6: a process for printing an image on a substrate comprising applying thereto a composition comprising a liquid medium and a tris-azo compound of Formula (1) or salt thereof wherein:

A is an optionally substituted alkenyl, homocyclic or heterocyclic group;

L1 and L2 are each independently optionally substituted aryl or heteroaryl; and

m and n are each independently 0 or 1 such that m+n is 1 or 2;

wherein:

(i) the compound of Formula (1) is optionally in the form of a metal chelate; and

(ii) at least one of L1 and L2 carries at least one substituent selected from sulpho, carboxy, C<sub>1-4</sub>-alkoxy and C<sub>1-4</sub>-alkoxy-OH

(iii) optional substituents present on L1 and L2 are selected from OH, SO<sub>3</sub>H, CN, carbonamido, PO<sub>3</sub>H<sub>2</sub>, CO<sub>2</sub>H, NO<sub>2</sub>, NH<sub>2</sub>, optionally substituted alkyl, optionally substituted alkoxy, optionally substituted aryl, optionally substituted amine and optionally substituted acylamine;

(iv) at least one of L1 and L2 carries at least one substituent selected from sulpho, carboxy, C<sub>1-4</sub>-alkoxy and C<sub>1-4</sub>-alkoxy-OH; and

(v) when L1 carries a methoxy group A is not 1,3-diaminophenyl (Formulas 1 and 3, page 1; page 5).

As per claim 9: wherein L1 is phenyl or naphthyl optionally carrying a substituent selected from sulpho or carboxy (page 1, lines 5-55).

As per claims 10 and 11: wherein L2 is phenyl or naphthyl carrying at least one substituent selected from sulpho, carboxy, C<sub>1-4</sub>-alkoxy-OH (page 1, lines 5-55)

As per claim 15: wherein a low melting point solid or a liquid medium comprising water and an organic solvent (example 1, page 3, lines 68-106) wherein the compound of formula 1 is not formula 3 or a salt thereof (page 1, formulas 1 and 3).

As per claim 16: a compound of formula 1 or a salt thereof and a low melting point solid or a liquid medium comprising water and an organic solvent (example 1, page 3, lines 68-106).

As per claim 17: a concentration of less than 500 ppm of halide ions, wherein parts refer to parts by weight relative to the total weight of the concentration (page 1).

As per claim 18, less than 50 ppm of divalent or trivalent metals, wherein parts refer to parts by weight relative to the total weight of the composition (page 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 20, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciba Limited (GB 741578 A) in view of Murcia et al. (US 20010012027 A1).

#### **Ciba Limited discloses the following claim limitations:**

The ink composition of claims 1 and 6.

#### **Ciba Limited does not disclose the following claim limitations:**

As per claim 2: the composition is applied to the substrate by means of an ink jet printer.

As per claim 3: the image is text, a picture, a photorealistic image, or a combination thereof.

As per claim 4: the substrate is paper, plastic, metal, or glass.

As per claim 20: an inkjet printer cartridge, optionally refillable, comprising one or more chambers and a composition.

As per claims 22 and 23: an overhead projector slide or a textile material.

**Murcia et al. disclose the following claim limitations:**

As per claim 2: the composition is applied to the substrate by means of an ink jet printer [0002].

As per claim 3: the image is text, a picture, a photorealistic image, or a combination thereof [0004].

As per claim 4: the substrate is paper, plastic, metal, or glass [0008].

As per claim 20: an inkjet printer cartridge, optionally refillable, comprising one or more chambers and a composition (figure 2).

As per claims 22 and 23: an overhead projector slide or a textile material [0008].

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ink taught by Ciba Limited with the disclosure of Murcia et al. in order to provide a method for printing high quality images.

***Allowable Subject Matter***

Claims 5, 7, 8, 12, and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.




Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura E. Martin whose telephone number is (571) 272-2160. The examiner can normally be reached on Monday - Friday, 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Laura E. Martin

  
**MANISH S. SHAH**  
**PRIMARY EXAMINER**